

Remarks

The instant Office Action dated July 6, 2009 listed the following new grounds of rejection: claims 1 and 16 stand rejected under 35 U.S.C. § 112(2); claims 1 and 5-18 stand rejected under 35 U.S.C. § 102(b) over Massie (U.S. Patent No. 6,285,175); claim 2 stands rejected under 35 U.S.C. § 103(a) over the '175 reference in view of Irvine (U.S. Patent No. 6,225,859); and claims 3-4 stand rejected under 35 U.S.C. § 103(a) over the '175 reference in view of Schneiderman (U.S. Patent No. 4,301,801). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Regarding the § 112(2) rejection of claims 1 and 16, first, Applicant would submit that the rejection was presented based on a previous version of claim 16. Secondly, the Office Action has not asserted that the cited language of claim 1 and claim 16 (previous version) is indefinite, but instead appears to be suggesting that additional limitations, directed toward the additional path, should be added to the claim. Thus, the Office Action is attempting to limit the breadth of the claims by improperly asserting indefiniteness. Such an assertion is contrary to M.P.E.P. § 2173.04 because the "[b]readth of a claim is not to be equated with indefiniteness." *See In re Miller*, 441 F.2d 689 (CCPA 1971). Applicant respectfully traverses the rejection.

Applicant respectfully traverses the § 102(b) and § 103(a) rejections because the cited '175 reference, alone or in combination with the '859 or '801 references, lacks correspondence. Particularly, the asserted reference(s) fails to disclose an additional current path formed "such that a current flowing through said additional current path reaches basically immediately a desired value, when said additional current path is opened" as claimed in claim 1, or the opening of a controllable additional data path in which current "flows basically immediately" as claimed in claim 10. The additional current path cited in the '175 reference does not disclose a path that will pass current and "basically immediately" reach a "desired value" because the cited path between "output of inductor 230 and Ground via inductor 280 and transistor 310" passes through inductor 280. When transistor 310 opens the path, due to the transient response of inductor 280, inductor 280 will initially act as an open circuit. Over time, the current through the inductor will rise and eventually reach the maximum value allowed by the circuit. Therefore, due to this transient

delay, the path disclosed by the '175 reference does not pass current "basically immediately" and does not disclose every element of either claim 1 or 10. The '859 and '801 references fail to cure this deficiency. Rather, one of ordinary skill in the art would recognize the use of an inductor in the '175 reference as teaching away from the use of the current path to basically immediately set current flow to a desired value.

Applicant further traverses the § 103 rejection of claim 2 because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('175) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). The purpose of the '175 invention is to suppress voltage transients in the output voltage of a power converter. Applicant submits that the combination of the controllable current source disclosed in the '859 reference would render the '175 invention inoperable for its intended purpose because the '859 reference does not teach that the current source is controllable by a circuit based on a reference voltage of the circuit. If the controllable current source of the '859 reference is incorporated with the current path of the '175 reference, it will be unable to compensate for transient variations in the output current unless the controllable current source is controlled by the circuit in response to the output voltage. Because the combination would be unable to suppress voltage transients, it would not function as intended by the '175 reference. Under M.P.E.P. § 2143.01, the rejection cannot be maintained.

Applicant further traverses the § 103 rejection of claims 3 and 4 because the cited '801 reference teaches away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). Applicant

submits that the '801 reference does not provide a motivation or suggestion to combine the disclosed low impedance path with a resistor with the invention of the '175 reference. The '801 reference teaches that the purpose of the resistor is to compensate for device leakage. Because device leakage is constant, the '801 reference does not provide any motivation to make the combination. Rather, the '801 reference teaches away from the combination with the '175 reference because the '801 reference teaches that the disclosed capacitor 38 (FIG. 2; Col. 4:5-10) filters out any RF or switching transients, implying that the low impedance path alone is insufficient to compensate for such transients. Under M.P.E.P. § 2143.01, the rejections cannot be maintained.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Name: Robert J. Crawford
Reg. No.: 32,122
651-686-6633 x2300
(NXPS.302PA)